

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN W. TAYLOR

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Appeal No. 1999-2795  
Application 09/046,111<sup>1</sup>

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ON BRIEF

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Before BARRETT, LALL, and GROSS, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed March 20, 1998, entitled (as amended in Paper No. 8) "Web of Record Members," which is a division of Application 08/574,703, filed December 19, 1995, now U.S. Patent 5,760,414, issued June 2, 1998.

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This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-8. The amendment after final rejection (Paper No. 8) filed July 19, 1999, has been entered.

We reverse.

#### BACKGROUND

The disclosed invention relates to a web of record members with crushed areas or cracks through the web so that the position of the web can be detected by an optical detector.

Claim 1 is reproduced below.

1. A web of record members adapted to be registered in a printer, comprising: a longitudinally extending web of printable record material, a series of optically detectable crushed areas in the record material web, the crushed areas being disposed at equally longitudinally spaced intervals for optically feed registering the record material web.

The Examiner relies on the following prior art:

Smith	3,958,051	May 18, 1976
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Smith discloses a composite label web having notches in one marginal side edge which can be sensed by a mechanical or optical sensor in a label applicator, a recorder such as

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an imprinter or perforator, or in a reader (col. 1, lines 43-49).

Claims 1, 3, 6, and 8 stand rejected under 35 U.S.C.  
§ 102(b) as being anticipated by Smith.

Claims 2, 4, 5, and 7 stand rejected under 35 U.S.C.  
§ 103(a) as being unpatentable over Smith.

We refer to the final rejection (Paper No. 5) (pages referred to as "FR\_\_") and the examiner's answer (Paper No. 9) (pages referred to as "EA\_\_") for a statement of the Examiner's position, and to the brief (Paper No. 7) (pages referred to as "Br\_\_") and the reply brief (Paper No. 10) for a statement of Appellant's arguments thereagainst.

#### OPINION

##### Grouping of claims

Appellant's grouping of claims states that each claim is discussed separately (Br4). While it would be best if Appellant used the magic phrase that "the claims do not stand or fall together," 37 CFR § 1.192(c)(7) (1999), to comply with the literal language of the rule, it is clear that Appellant's statement is equivalent to saying the claims do not stand or fall together. The claims are argued separately (Br4-5), although Appellant's arguments as to

claims 2, 4, 5, and 7 fail to address the Examiner's rationale (FR3) that the type of web is a matter of obvious design choice. The Examiner's statement that claims 1-8 stand or fall together because the brief does not include a statement that the claims do not stand or fall together and reasons in support thereof (EA2) is in error. The claims do not stand or fall together.

Claims 1-7

As to claim 1, the Examiner states (FR2): "Regarding 'crushed areas', the manner in which these areas or cracks are created constitutes a method step which is given little or no patentable weight in an apparatus claim."

Appellant argues that the claimed "crushed areas" represent structure, not a method step (Br4-5).

The Examiner responds to arguments concerning both claims 1 and 8 as follows (EA3-4):

[T]he specific manner in which "crushed areas" or "cracks" are created constitutes a method step, which is given little or no patentable weight in an apparatus claim. . . . The only difference between the holes of Smith and "crushed areas" or "cracks" of the claimed invention lies in the manner in which they are generated, not in their structural function. In fact, both a crack and a hole have the same structural function (i.e. enable light to pass through to detect

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discontinuity of a web). Appellant is invited to look in class 250, subclass 559.42, entitled "Discontinuity detection (e.g. hole, crack)" which indicates either a hole or a crack can be utilized to detect discontinuity. In addition, the term "crack" is defined by Webster's New World Dictionary, Third College Edition, as "a narrow opening". Within the normal definition of the term "crack", the hole of Smith, which clearly can be "a narrow opening" reads on the claimed "crack".

An apparatus claim containing a method of making step is a product-by-process claim. The patentability of product-by-process claims is based on the product itself. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). Where the end products are the same, the process of making limitations do not have to be given weight in ex parte examination. See Atlantic Thermoplastics Co. v. Faytex Corp., 970 F.2d 834, 846, 23 USPQ2d 1481, 1490-91 (Fed. Cir. 1992) (product-by-process claims are treated differently for patentability purposes during ex parte examination in the USPTO than for infringement and validity purposes during litigation). However, process of making limitations must be given weight to the extent they produce a different structure, i.e., to the extent the product produced by the step is different.

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In claim 1, the term "crushed areas" indicates a process of making the areas by "crushing." "Crush" is defined as "to squeeze or force by pressure so as to alter or destroy structure," Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977). Therefore, "crushed areas" indicates a definite structure as well as a method of making. The Examiner erred in failing to give patentable weight to the structure of "crushed areas." The Examiner also erred in stating that "[t]he only difference between the holes of Smith and 'crushed areas' or 'cracks' of the claimed invention lies in the manner in which they are generated, not in their structural function" (EA4). It is the structure, not the function of the structure which is at issue. The notches in Smith are defined by an absence of material, not material which has been altered in structure by squeezing, and, thus, the notches do not have the same structure as "crushed areas." Therefore, claim 1 is not anticipated by Smith. The anticipation rejection of claims 1, 3, and 6 is reversed. The obviousness rejection does not cure the deficiencies with respect to claim 1 and,

thus, the obviousness rejection of claims 2, 4, 5, and 7 is reversed.

Claim 8

Claim 8 recites "a crack in the carrier web." The crack is clearly a structural limitation. A "crack" is defined as "a narrow break : FISSURE," Webster's. We find that the rectangular or V-shaped notches in Smith are not cracks because they are not narrow breaks in the web. The Examiner erred in finding that the "hole" in Smith is a "crack" because "both a crack and a hole have the same structural function (i.e. enable light to pass through to detect discontinuity of a web)" (EA4). Again, it is the structure, not the function of the structure which is at issue. While it is true that a hole and a crack are both forms of discontinuities that may be detected, this does not mean that a hole is the same thing as a crack. We further disagree with the Examiner's finding that "the hole of Smith, which clearly can be 'a narrow opening' reads on the claimed 'crack'" (EA4) because the hole (or notch) in Smith is not shown to be a narrow opening in any reasonable

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interpretation of the term "narrow." For these reasons, the anticipation rejection of claim 8 is reversed.



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CONCLUSION

The rejections of claims 1-8 are reversed.

REVERSED

	LEE E. BARRETT	)	
	Administrative	Patent Judge	)
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		)	
		)	
		)	BOARD OF
PATENT	PARSHOTAM S. LALL	)	APPEALS
	Administrative Patent Judge	)	AND
		)	INTERFERENCES
		)	
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		)	
	ANITA PELLMAN GROSS	)	
	Administrative Patent Judge	)	

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